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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/016,070 | 12/05/2001 | James W. Coiner | 47496/VGG/C614 | 6974 |
| 23363 | 7590 | 11/25/2003 | EXAMINER | |
| CHRISTIE, PARKER & HALE, LLP 350 WEST COLORADO BOULEVARD SUITE 500 PASADENA, CA 91105 | | | LOCKER, HOWARD J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1661 | |

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES DEPARTMENT OF COMMERCE
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1124

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on September 09, 2003

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 233.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ ~~Some~~ The claim is ~~is~~ pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ ~~Some~~ The claim remains ~~is~~ rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

10/016070
PTOL-326 (Rev. 10/95)

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. The following is a quotation of section (a) of 37 CFR 1.163:

"(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered."

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor in carrying out his invention."

In plant applications filed under 36 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

"No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

“The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.”

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known varieties and antecedents.

A. The Genus/species designation of the instant cultivar must be set forth in the specification (assumedly such is *Rosa hybrida*). Applicant's addition of the family name Rosaceae is per se acceptable for what it shows, but needs to be properly depicted as such rather than improperly as a Genus as is currently the case in the specification (see 1B of the previous Office action).

B. Relative to the recitation at lines 26-28 of page 3 of the substitute specification, such should be amended to more accurately account for the expression of the plant, particularly as a three leaflet leaf is illustrated (see 1E of the previous Office action).

C. Peduncle coloration should be accounted for more fully, so as to account for coloration other than the anthocyanin blush (see 1O of the previous Office action).

D. The newly added language relative to prickle/thorn quantity should be reviewed for accuracy as the photographic illustration of record does not appear to reasonably correspond to the designation “very few prickles and thorns” as is now recited in the specification.

E. Information should be imported into the specification as to whether the petals persist or drop. Previously, the specification contained “Persistence” Strong”, but such was only apparently reflective of the petaloids, or else the information was not presented in the correct form in the specification. Correction and/or clarification is necessary (see 1R of the previous Office action).

F. Petal shape and margin should be more meaningfully accounted for in the specification (see 1S of the previous Office action). The new characterization of petal margin as “serrate” does not appear to reasonably correspond to the plant as illustrated, and does not appear to be normal for the species.

G. The section of the specification dealing with reproductive organs should be reorganized so that such reads correctly. For example, see the heading which appears at lines 4-5 of page 7, and the description thereof which appears also at lines 4-2 of page 7. The latter obviously should be moved to begin at line 5 rather than line 4.

H. The color designations set forth in the specification relative to petal coloration do not reasonably correspond to the plant as illustrated (see the second 1T of the previous Office action). Specifically, the petal color designations appear to be several too light, and in no way can be properly characterized as being dark red (page 6, lines 25-27 of the substitute specification). However, it is noted that the bud color designations currently set forth in the specification do in fact look to reasonably correspond to the open bloom illustrated.

While such does not appear to be the case from the record at present, should the source of the noted discrepancy be the submitted photographic illustration, it would be necessary for applicant to file a substitute therefor (see 37 CFR 1.165(a) and 1.165(b)). Two copies of such would need to be furnished.

If the bloom color designations set forth in the specification are determined to be correct, it would be necessary for applicant also to amend the generic bloom color description in the written specification and abstract as such would then not reasonably be characterized as either red or as dark red.

I. In the previous Office action (see 1W), the examiner asked for additional information relative to the cultivar's observed and characteristic disease resistance, such being particularly germane as the cultivar looks to be a garden or landscape hybrid tea cultivar and as applicant's specification specifically recites botanical characteristics of the plant as grown outdoors in Wasco, California. Responsive thereto, applicant has come forth with no information. If additional information is now available relative to disease resistance/susceptibility at the specified location of culture, such should be accounted for in the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible.

2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs, as not being supported by a clear and complete botanical description of the plant, for the reasons advanced in paragraph 1 above.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/prcognotice/revamdtprac.htm>

5. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

6. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.

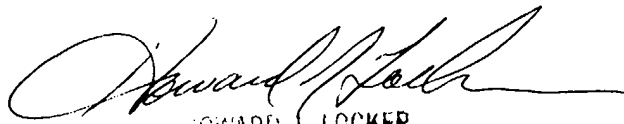
Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 703-308-0196.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to TC 1600 by facsimile transmission. Papers should be faxed to this TC via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for TC 1600 is 703-872-9306.

Howard J. Locker/hjl

November 24, 2003


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661